

**E-Filed 7/26/2010 **

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION**

BECKMAN COULTER, INC., a Delaware
corporation,

Plaintiff,

v.

BECKCOULT.COM, a Domain Name, and DOES
1 through 20, inclusive,

Defendants.

Case Number C 10-03110 JF (PVT)

**ORDER GRANTING PLAINTIFF'S
EX PARTE APPLICATION FOR
TEMPORARY RESTRAINING
ORDER AND ORDER TO SHOW
CAUSE RE PRELIMINARY
INJUNCTION**

Plaintiff seeks a temporary restraining order ("TRO") and a preliminary injunction to prevent Defendants from infringing Plaintiff's trademark and intellectual property rights. The Court has considered the moving papers, declarations, and exhibits presented by Plaintiff's counsel. For the reasons discussed below, a TRO will be granted. A hearing on Plaintiff's motion for a preliminary injunction will be set for August 6, 2010 at 9:00A.M.

I. BACKGROUND

Plaintiff Beckman Coulter ("Plaintiff") filed the instant action on July 15, 2010. The dispute arises out of Defendants' alleged use of a website that is essentially identical to

Plaintiff's. Plaintiff alleges that Defendants' use of the website violates the Anticybersquatting Consumer Protection Act ("ACPA"), 15 U.S.C. § 1125(d)(2), Section 32(a) of the Lanham Act, 15 U.S.C. § 1114(1), Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), (b), Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), California Common Law Trademark Infringement, Section 43(d) of the Lanham Act, 15 U.S.C. § 1125(d), Unfair Competition and False Designation of Origin Law, Cal. Bus. & Profs. Code §§ 17200 & 17500. (Compl. ¶¶ 1-2.)

Plaintiff is a Delaware corporation with its principal place of business in Brea, California. (Compl. ¶ 6.) For approximately seventy-five years, Plaintiff and its predecessors have manufactured and sold products used in biomedical testing. (Compl. ¶ 12.) Plaintiff sells its biomedical testing equipment and products through a variety of marketing channels, including its principal website *www.beckmancoulter.com*. (Compl. ¶¶ 13-14.) Plaintiff also maintains a website at *www.coulterflow.com*. (Compl. ¶ 14.) The latter website has an electronic commerce feature which allows Plaintiff's customers to order products by creating and accessing customer accounts using unique passwords. (Compl. ¶ 14; Pl.'s Mem. 3)

Plaintiff depends upon both the quality of its products and the reliability of its brand, and it has spent substantial sums to secure and protect its intellectual property interests. (Compl. ¶ 16.) Plaintiff has obtained numerous federal trademark registrations to protect the value of its Beckman Coulter® brand in connection with its medical testing equipment, including federal registrations Nos. 2,742,502, 2,756,542, 2,884,295, and 2,970,877. (Compl. ¶ 17.)

Beckcoulter.com is a domain name registered through the registrar Melbourne IT, Ltd. d/b/a Internet Names Worldwide, a company located in Australia (the "Registrar"). (Compl. ¶ 7.) The Beckcoulter.com domain name resides with Verisign, Inc. ("Verisign"), which is exclusively responsible for maintaining the <.com> registry. (Compl. ¶ 7.) Verisign's principal place of business is in Mountain View, California. (Compl. ¶ 7.) Defendants DOES 1-10 are individuals of unknown residence and citizenship. (Compl. ¶ 8.) Defendants DOES 11-20 are corporations of unknown places of incorporation. (Compl. ¶ 9.)

On or about May 15, 2010, the Doe Defendants registered the Beckcoulter.com domain name under one or more false identities. (Compl. ¶ 29.) Later that same month, Plaintiff was

1 notified by third parties that unauthorized entities were using the Beckcoults.com domain name
2 to pose as Plaintiff as part of a “phishing fraud” scheme allegedly designed to defraud third-
3 party Internet users. (Pl.’s Mem. 3) Since that time, several other third-party internet users have
4 reported receiving emails from an individual using an email address incorporating the
5 Beckcoults.com domain name. (Compl. ¶ 33.) Specifically, on May 19, 2010, a third party was
6 sent an email from someone posing as one of Plaintiff’s employees seeking price quotes for
7 computer networking equipment. (Compl. ¶ 33.) Although the email purports to originate from
8 Plaintiff, it was not sent by anyone affiliated with or authorized by Plaintiff. (Compl. ¶ 33; Pl.’s
9 Mem. 4) Plaintiff contends that the Beckcoults.com domain name furthers the phishing fraud
10 scheme by creating the false appearance that an email had been sent by someone affiliated with
11 or authorized by Plaintiff. (Pl.’s Mem. 4) It appears that the goal of this scheme is to facilitate
12 the unknown registrants’ receipt and theft of expensive equipment. (Pl.’s Mem. 4)

13 Following the May 19, 2010 incident, there was a spate of additional incidents involving
14 individuals posing as Plaintiff’s employees using the Beckcoults.com domain name. (Pl.’s Mem.
15 4) On May 28, 2010, one of Plaintiff’s vendors reported having received a forged order for
16 networking equipment in Plaintiff’s name. (Compl. ¶ 33.) That vendor later reported having
17 sent equipment worth approximately \$32,000 to an address in Louisiana in response to those
18 emails and forged documents. (Kirtland Decl. ¶ 9.)

19 Upon learning of the phishing fraud scheme, Plaintiff published a fraud alert on the
20 beckmancoulter.com website. (Kirtland Decl. ¶ 11.) Plaintiff also began working with federal
21 law enforcement agencies, including the Department of Homeland Security, to investigate the
22 scheme. (Kirtland Decl. ¶ 11.) The law enforcement investigation revealed that at least some of
23 the redirected hardware shipments were destined for the Republic of Benin, a country that
24 borders Nigeria in West Africa. (Kirtland Decl. ¶ 11.) Plaintiff suggests that the Republic of
25 Benin may be where the perpetrators of the fraud and Beckcoults.com registrants are located.
26 (Pl.’s Mem. 5)

27 On July 9, 2010, fraudulent use of the Beckcoults.com domain name escalated further,
28 prompting Plaintiff to file the instant action. (Pl.’s Mem. 5) On that date, Plaintiff learned that

1 an exact copy of its interactive coulterflow.com website had appeared at the Beckcoult.com
 2 website. (Compl. ¶ 33.) Plaintiff alleges that the copied website now allows the Doe
 3 Defendants to impersonate Plaintiff in a manner that encourages registered users of its website
 4 to submit private account information, including user names and passwords, directly to
 5 Defendants. (Compl. ¶ 38.)

6 After learning that the Doe Defendants were attempting to use the Beckcoult.com
 7 domain name to collect Plaintiff's customers login and password information directly, Plaintiff's
 8 counsel immediately notified the Beckcoult.com registrants. (Pl.'s Mem. 5) On July 9, 2010
 9 and July 10, 2010, Plaintiff's counsel sent notice to the unknown registrant of the
 10 Beckcoult.com domain name at the email address and post office box listed with the registrar.
 11 (Compl. ¶ 40.) On July 12, 2010, Plaintiff learned that the Doe Defendants and unknown
 12 registrants of the Beckcoult.com domain name had changed their contact information with the
 13 registrar. (Compl. ¶ 43.) That same day, Plaintiff's counsel sent additional cease and desist
 14 correspondence to the registrants' updated email address. (Compl. ¶ 44.) The additional cease
 15 and desist correspondence email was returned as undeliverable. (Compl. ¶ 45.) On July 13,
 16 2010, Plaintiff received notice that the Postal Service was unable to deliver the mail sent to the
 17 registrants' post office box. (Compl. ¶ 41.) To date, Plaintiff has not received any response
 18 from the Doe Defendants or the unknown registrants of the Beckcoult.com domain name.
 19 (Compl. ¶ 47.)

20 II. LEGAL STANDARD

21 The standard for issuing a TRO is the same as that for issuing a preliminary injunction.
 22 *Brown Jordan Int'l, Inc. v. Mind's Eye Interiors, Inc.*, 236 F. Supp. 2d 1152, 1154 (D. Hawaii
 23 2002); *Lockheed Missile & Space Co., Inc. v. Hughes Aircraft Co.*, 887 F. Supp. 1320, 1323
 24 (N.D. Cal. 1995). A preliminary injunction is "an extraordinary remedy that may only be
 25 awarded upon a clear showing that the plaintiff is entitled to such relief." *Winter v. Natural Res.*
 26 *Def. Council, Inc.*, 129 S.Ct. 365, 376 (2008). "The proper legal standard for preliminary
 27 injunctive relief requires a party to demonstrate [1] 'that he is likely to succeed on the merits, [2]

1 that he is likely to suffer irreparable harm in the absence of preliminary relief, [3] that the
 2 balance of equities tips in his favor, and [4] that an injunction is in the public interest.”
 3 *Stormans, Inc. v. Selecky*, 586 F.3d 1109, 1127 (9th Cir. 2009) (citing *Winter*, 129 S. Ct. at
 4 374)). The issuance of a preliminary injunction is committed to the discretion of the District
 5 Court. *Indep. Living Ctr.*, 572 F.3d at 651.

6 A TRO may be issued without notice to the adverse party *only if* “(A) specific facts in an
 7 affidavit or a verified complaint clearly show that immediate and irreparable injury, loss, or
 8 damage will result to the movant before the adverse party can be heard in opposition; and (B)
 9 the movant’s attorney certifies in writing any efforts made to give notice and the reasons why it
 10 should not be required.” Fed. R. Civ. P. 65(b)(1). Moreover, in this district an applicant for a
 11 TRO must give notice to the adverse party “[u]nless relieved by order of a Judge for good cause
 12 shown, on or before the day of an *ex parte* motion for a temporary restraining order.” Civ. L.R.
 13 65-1(b).

14 III. DISCUSSION

15 Plaintiff’s complaint alleges seven claims for relief. (Compl. 1-2) In seeking a TRO,
 16 Plaintiff focuses on Defendants’ alleged violation of the Anti-Cybersquatting Consumer
 17 Protection Act, 15 U.S.C. § 1125(d)(2). (Pl.’s Ex Parte Application for TRO 2) The Court
 18 concludes that Plaintiff has shown good cause for issuance of a temporary restraining order and
 19 order to show cause re preliminary injunction.

20 1. PLAINTIFF IS ENTITLED TO A TRO

21 A. Likelihood of success on the merits

22 In order for a TRO to be granted, a plaintiff must show that it is likely to succeed on the
 23 merits of a claim that would entitle it to the equitable remedy that it seeks. *Stormans*, 586 F.3d
 24 at 1127. The Ninth Circuit has recognized that “cybersquatting occurs when a person other than
 25 the trademark holder registers the domain name of a well known trademark and then attempts to
 26 profit from this by either ransoming the domain name back to the trademark holder or by using
 27 the domain name to divert business from the trademark holder to the domain name holder.”
 28

Bosley Med. Inst., Inc. v. Kremer, 402 F.3d 672, 680 (9th Cir. 2005). To prove a violation of the Anticybersquatting Consumer Protection Act provides, a plaintiff must show that (1) it owns a trademark that is “distinctive [or famous] at the time of registration of the domain name, (2) Defendants “registered, trafficked in, or used a domain name” that is “identical or confusingly similar” to Plaintiff’s mark, and (3) Defendants had a bad faith intent to profit from Plaintiff’s mark. 15 U.S.C. § 1125(d)(2); see also *Bosley Med. Inst., Inc.*, 402 F.3d at 681, citing *DaimlerChrysler v. The Net Inc.*, 388 F.3d 201, 204 (6th Cir.2004).

Plaintiff has established that it owns one or more of the referenced incontestable Marks. (Pl.’s Mem. 8) “Registered trademarks are presumed to be distinctive and should be afforded the utmost protection.” *Americana Trading, Inc. v. Russ Berrie & Co.*, 966 F.2d 1284, 1287 (9th Cir. 1999); see also 15 U.S.C. § 1115(a) (“Any registration ... on the principal register ... shall be prima facie evidence of the validity of a registered mark”). It also is apparent that the Beckcoults.com domain name is confusingly similar to the Beckman Coulter® Mark. (Pl.’s Mem. 8) The Beckcoults.com domain name is an easily identifiable abbreviation of the Beckman Coulter® Mark, and is not materially distinguishable from the Beckman Coulter® Mark.

The ACPA lists nine factors that may be considered when determining whether bad faith intent to profit exists. See 15 U.S.C. § 1125(d)(B)(I). One such indication of bad faith occurs when a person intends to “divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark.” 15 U.S.C. § 1125(d)(B)(I)(5). In the instant action, the evidence in the record suggests that Defendants used their perceived affiliation with Plaintiff to purchase expensive computer networking equipment and to capture Plaintiff’s user’s account information. (Kirtland Decl. ¶¶ 9, 17.) This appears to have been done for the sole purpose of diverting Plaintiff’s customers away from Plaintiff’s website for Defendants’ own commercial gain.

B. Irreparable harm

Preliminary injunctive relief is appropriate where plaintiffs “demonstrate that irreparable injury is likely to occur in the absence of an injunction.” *Johnson v. Couturier*, 572 F.3d 1067,

1 1081 (9th Cir. 2009) (citing *Winter*, 129 S. Ct. at 375). In a trademark infringement case,
 2 “[i]rreparable injury is ordinarily presumed upon a showing of a likelihood of success.” *Super-*
 3 *Krete Int’l, Inc.*, 2010 U.S. Dist. LEXIS 50090, *26-27 (C.D. Cal. Apr. 22, 2010) (citing
 4 *Abercrombie & Fitch Co. v. Moose Creek, Inc.*, 486 F.3d 629, 633 (9th Cir. 2007).

5 **C. Balance of hardships**

6 The Supreme Court has recognized that courts must “balance the competing claims of
 7 injury and must consider the effect on each party of the granting or withholding of the requested
 8 relief.” *Amoco Production Co. v. Village of Gambell, AK*, 480 U.S. 531, 542 (1987). Here,
 9 Plaintiff has not authorized Defendants to act on its behalf or to assume its identity for any
 10 purpose. (Pl.’s Mem. 9) There is no evidence that Defendants will incur any hardship from an
 11 order preventing further operation of the Beckcoult.com website until this litigation is resolved.
 12 Accordingly, the balance of hardships tips sharply in favor of Plaintiff.

13 **D. Public interest**

14 The public interest analysis for the issuance of a TRO requires courts to consider “whether
 15 there exists some critical public interest that would be injured by the grant of preliminary relief.”
 16 *Indep. Living Ctr. Of S. Cal., Inc. v. Maxwell-Jolly*, 572 F.3d 644, 659 (9th Cir. 2009) (quoting
 17 *Hybritech Inc. v. Abbott Labs.*, 849 F.2d 1446, 1458 (Fed.Cir.1988)). In the instant action, absent
 18 an injunction, the public as well as Plaintiff’s customers stand to continue to be defrauded and
 19 suffer the theft of their personal information through Defendants’ phishing fraud scheme.
 20 (Compl. ¶ 33; Kirtland Decl. ¶¶ 9.)

21 **2. PLAINTIFF MAY SERVE NOTICE BY EMAIL**

22 Rule 65(b) of the Federal Rules of Civil Procedure authorizes courts to issue a TRO
 23 “without written or oral notice to the adverse party” when “the movant's attorney certifies in
 24 writing any efforts made to give notice and the reasons why it should not be required.” Fed. R.
 25 Civ. P. 65(b)(1)(B).

26 In the instant action, Plaintiff’s counsel has certified in writing that he has made multiple
 27 efforts to give Defendants notice. Plaintiff’s counsel also has explained adequately in writing
 28 why a TRO should issue without notice. (Compl. ¶ 40; Wisniewski Decl., ¶ 5.d.) Despite its

1 reasonable efforts to give notice, Plaintiff has not received any response from Defendants.
2 (Compl. ¶ 47; Wisniewski Decl., ¶ 5.g.) Accordingly, the Court grants the requested leave to
3 serve the complaint and notice of the TRO by email.

4 **IV. Conclusion**

5 Pending the hearing on Plaintiff's motion for a preliminary injunction and further order of
6 the Court, Defendants are hereby temporarily enjoined and restrained from operating or
7 maintaining any website using the Beckcoult.com domain name or any other domain name owned
8 or used by Plaintiff. Plaintiff's request for leave to serve the complaint and notice of the TRO by
9 email is granted. A hearing on Plaintiff's motion for preliminary injunctive relief is scheduled for
10 August 6, 2010, at 9:00 A.M.

11 **IT IS SO ORDERED**

12 DATED: July 26, 2010

13 
14 JEREMY FOGEL
United States District Judge